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In re Application of
Daniel A. Gately
Serial No.: 09/016,641
Filed: January 30, 1998
Attorney Docket No.:

PETITION DECISION

This is in response to applicant's second renewed petition under 37 CFR 1.144, filed March 10, 2000, requesting reconsideration of the petition decisions of mailed September 21, 1999, and January 10, 2000.

Applicant reiterates the position that it is improper to restrict within a claim, or in other words to have the same claim assigned to multiple groups of invention. Applicant's position is noted, however since this applies only to Groups I, II and IV, none of which were elected, the issue is considered moot. Applicant's election of Group V, in which none of the claims are assigned to any other Group, with traverse was proper. In petitioning the restriction requirement, applicants sought to have all claims examined as a single group even though the claims of Groups I and II are to compounds and the claims of Groups II, IV and V are to methods of making compounds. It was further noted that the method of Group V is to a method of making a compound involving a ligand to which none of the compound/composition claims are directed. The restriction was therefor deemed proper. Since the restriction requirement was not modified, no discussion of the propriety of the claims in the non-elected groups is necessary or warranted.

To reaffirm, the group V claims are to a method of reacting a -CH group in a compound with an RM group, M being a metal, to form a -CM compound which is then further reacted with silyl or aminosilyl compound to form a final product. Groups III and IV are to a method of making a silyl or aminosilyl compound. The reaction methods and products produced are not the same and therefor the restriction between the method claims is proper.

The petition decisions mailed September 21, 1999, and January 10, 2000, have been reviewed in light of applicant's request for reconsideration, however the decisions are not found to be in error.

Applicants' renewed petition is **DENIED**. The restriction requirement set forth by the examiner under 35 U.S.C. 121 is proper and is maintained.

Any request for reconsideration or review of this decision must be by way of a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600/2900, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 308-7922.



John Kittle

Director, Technology Center 1600/2900